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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/767,642 | 01/29/2004 | Scott P. Steinmann | 630666.91179 | 5403 |

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| EXAMINER |
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MILLER, CHERYL L

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| ART UNIT | PAPER NUMBER |
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3738

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| MAIL DATE | DELIVERY MODE |
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06/20/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--------------------------------------|--|--|
| Office Action Summary | Application No. 10/767,642 | Applicant(s) STEINMANN, SCOTT P. | |
| | Examiner Cheryl Miller | Art Unit 3738 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 May 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 2 and 4-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4-6, 8-9 is/are rejected.
- 7) ☒ Claim(s) 7 and 10 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on April 30, 2007 has been entered.

Response to Arguments

Applicant's arguments with respect to claims 1, 2, and 4-10 have been considered but are moot in view of the new ground(s) of rejection.

The applicant has argued that Rauscher et al. (US 6,887,277 B2) does not disclose the head inner surface to be spaced from the stem end. The examiner disagrees. First the head inner surface near the aperture is spaced, *at least axially* away from the end of the stem after securement. Also, the head inner surface inherently must also be spaced some radially from the stem end portion, since movement is allowed until the screw secures and tightens into the stem, even when secured to the stem, only the screw touches the stem, that is if indeed the inner surface of the head touched the stem, no movement would be allowed at anytime prior to securement.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-2, 5-6, and 8-9 are rejected under 35 U.S.C. 102(e) as being anticipated by Rauscher et al. (US 6,887,277 B2, cited previously). Rauscher discloses a prosthesis (see fig.11) comprising a stem (5+35), a head (33) having an outer wall (thickness of head) defining an interior space (19), wherein the head (33) may be placed over the stem end (35) adapted for transverse and axial movement (flexible head is compressible, allowing movement in multiple directions), the outer wall of the head having *at least one* opening (see fig.11), a screw (34) arranged in each opening adapted to contact the end of the stem and secure the head by constraining axial and transverse movement (see fig.11; col.4, lines 60-65), wherein each opening is in a lateral direction to the stem axis (seen in fig.11 as perpendicular to the stems longitudinal axis) and an interior surface of the head wall adjacent the aperture is spaced from and end of the stem (adjacent aperture is spaced axially from the stem head; adjacent aperture is spaced radially also, inherently since relative movement occurs prior to securement by screw in order to orient and fix in the correct position; col.4, lines 60-65; also one can not assume that the figures are to scale), and wherein the screw contacts a side surface of the end of the stem (see fig.11). Replacement of a radial head is intended use language, the head of Rauscher is capable of replacing a radial head.

Claims 1, 2, 4-6, and 8-9 are rejected under 35 U.S.C. 102(e) as being anticipated by Masini (US 6,821,300 B2). Masini discloses a prosthesis (see fig.3-6) comprising a stem (310), a head (330) having an outer wall (thickness) defining an interior space, wherein the head (330)

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may be placed over the stem end (310) adapted for transverse and axial movement, the outer wall of the head having *at least one* opening (three or more openings, see fig.3), a screw (332) arranged in each opening *adapted* to contact the end of the stem (screws are capable of being threaded to contact the stem) and secure the head by constraining axial and transverse movement, wherein each opening is in a lateral direction to the stem axis (seen in fig.3) and an interior surface of the head wall adjacent the aperture is spaced from an end of the stem (fig.3,4, 5), and wherein the screw (332) contacts a side surface of the end of the stem (adapted to be threaded more to contact the stem through the bone). Replacement of a radial head is intended use language, the head of Rauscher is capable of replacing a radial head.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rauscher et al. (US 6,887,277 B2, cited previously). Rauscher discloses a prosthesis having a stem and head adapted to be secured onto the stem by an opening/screw connection (see above). Rauscher however discloses only one opening/screw (34 in fig.11) instead of three as claimed. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have three openings instead of three, since the result would be merely further security and a duplication of the original parts. *In re Harza*, 274 F.2d 669, 124 USPQ 378 (CCPA 1960).

Allowable Subject Matter

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Claims 7 and 10 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

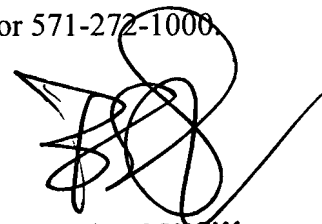
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cheryl Miller whose telephone number is (571) 272-4755. The examiner can normally be reached on Monday-Friday 7:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on (571) 272-4755. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Cheryl Miller



BRUCE SNOW
PRIMARY EXAMINER